



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,923	12/19/2001	James Thacker	8109.003.USDV	9929

28694 7590 10/17/2006  
NOVAK DRUCE & QUIGG, LLP  
1300 EYE STREET NW  
400 EAST TOWER  
WASHINGTON, DC 20005

EXAMINER
----------

HINES, JANA A

ART UNIT	PAPER NUMBER
----------	--------------

1645

DATE MAILED: 10/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/020,923

Applicant(s)

THACKER, JAMES

Examiner

Ja-Na Hines

Art Unit

1645

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 09 August 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☒ The Notice of Appeal was filed on 09 August 2006. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☒ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☒ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See continuation sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: None.  
Claim(s) objected to: None.  
Claim(s) rejected: 11 and 29-32.  
Claim(s) withdrawn from consideration: 6-10, 12-19 and 25-28.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

  
MARK NAVARRO  
PRIMARY EXAMINER

The proposed after final amendment raises new issues that would require further consideration and/or search. The proposed amendment raises issues of new matter. The claims are now drawn to determining the amount of microorganisms from the reporter-primary antibody complexes detected wherein the method is performed in less than 8 hours. The new matter of the proposed amendment, is drawn to the method being performed in less than 8 hours. Applicants' point to pages 6-8 of the instant specification for support. However, page 7, lines 17, states that the incubation period can be less than 8 hours. There is no teaching that the method can be performed in less than 8 hours. Therefore the amendment is drawn to new matter. Furthermore, the proposed amendment presents 4 new claims without canceling a corresponding number of finally rejected claims. Thus, the proposed after final amendment will not be entered for the reasons stated above.

Therefore applicants arguments are moot in view of the proposed amendments not being entered.

The rejection of claims 11 and 29-32 under 35 U.S.C. 103(a) as being unpatentable over Shih et al., (US Patent 4,026,767 published May 31, 1977) in view of Harlow and Lane (1986) is maintained. Applicant argues that the references teach away from the claimed invention because they disclose using a longer incubation period. However, it is the examiner's position that disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. Therefore contrary to applicants' argument, the prior art does not teach away from the instant claims, since the instant claims assert no discovery beyond what was known in the art. Applicants' urge that the prior art does not recite teaching of formazan. However it is the examiner's position that the references failure to show a teaching of formazan is not recited in any of the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. Furthermore, one of ordinary skill in the art would have a reasonable expectation of success because one of ordinary skill in the art would have been motivated to make such changes in method since it is well known in the art of immunoassays to use antibodies specific and sensitive within the colorimetric assays taught by Shih et al. Thus, applicants' arguments are not persuasive and the rejection is maintained.

The rejection of claims 11 and 29-32 under 35 U.S.C. 112, second paragraph, is maintained for reasons of record. Thus, applicants' arguments are not persuasive and the rejection is maintained.